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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,875

Applicant(s)

HOYT ET AL.

Examiner

Stephen M Gravini

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2,3,4.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Specification

The specification is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. Specifically, a link is referred in the specification on page 11, which may contain information different from the link when the application was drafted more than four years from this examination. See MPEP § 608.01. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created

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vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete, and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). Together, the "technological arts" and "useful, concrete, and tangible result" judicial review standard, result in a comprehensive examination standard wherein the "technological arts" is one element and the "useful, concrete, and tangible result" is another complementary element.

This comprehensive examination standard was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA

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1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement

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issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. The Board of Patent Appeals and Interferences (BPAI) have recently acknowledged this dichotomy in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001).

Claims 1, 2, 5-8, 10, 12, 35, and 36 are rejected under 35 U.S.C. 101 because the independently claimed invention does not recite a useful, concrete, and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998) such that the claimed invention is within the technological arts under *In re Waldbaum* 173 USPQ 430 (CCPA 1972) wherein the phrase "technological arts" is synonymous with "useful arts" as it appears in Article I, Section 8 of the United States Constitution. In this claim, it is considered that a concrete and tangible result within the technological arts is not recited. Specifically, the claim recitation of allowing, determining, retrieving, receiving, creating, searching, advertising, displaying, storing, registering, providing, and

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identifying is considered not to produce a concrete result because each claim recitation is considered an abstract concept that is not within the technological arts because those claimed features are not synonymous with useful arts as decided in *Waldbaum*.

Furthermore, under *In re Wamerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994), the allowing, determining, retrieving, receiving, creating, searching, advertising, displaying, storing, registering, providing, and identifying recitations are considered intangible because those steps are simply an abstract construct, such as a disembodied data structure and a method of making it, wherein those recitations involve more than a manipulation of an abstract idea and therefore is non-statutory under 35 USC 101.

Because the independently claimed invention does not recite a useful, concrete, and tangible result, such that it is considered not within technological arts so that it uses technology in a non-trivial matter. Finally under *Ex parte Bowman*, 61 USPQ2d 1665 (Bd. Pat. App. & Inter. 2001) (unpublished but cited for analysis rather than precedent), in which an invention disclosed and claimed directed to a human merely making mental computations and manually plotting results on a paper chart is nothing more than an abstract idea which is not tied to any technological art and is not a useful art as contemplated by the United States Constitution. In this independently claimed invention, the steps of allowing, determining, retrieving, receiving, creating, searching, advertising, displaying, storing, registering, providing, and identifying are considered nothing more than an abstract idea since it is not tied to any technological art. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 13, 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggleston et al. (US 6,061,660) and Nielsen (US 5,854,630) wherein the claimed RLS or return link system is defined in functionality terms in Nielsen. In Nielsen, the cursor back or forward button placement allowing a list of recently visited URL's performs the same function, in the same manner or means, with the same result as the claimed RLS. As a premise, examiner considers the claimed cookie to be that of the Microsoft dictionary definition wherein a cookie is defined as a block of data that server returns to a client in response to a request from the client. This definition is consistent with the use in the claims and discussion in applicants' specification.

Eggleston is considered to teach a method and system comprising:

allowing a user to access a host site, wherein said host site is located on a server or a user system configured to access a host site, wherein said host site is located on a server; wherein said user system is referred to said host site by a referring member (column 11 lines 1-20);

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determining if the user system was referred to said host site by a referring member (column 12 lines 38-48);

retrieving information associated with said referring member from a referring member profile database or said host site configured to retrieve information associated with said referring member from a referring member profile (column 12 lines 12-37); and

displaying on said host site indicia sponsored by said referring member or said host site configured to display indicia sponsored by said referring member (column 14 lines 6-19). Eggleston is considered to also disclose a cookie and cross-reference IP address (column 10 lines 28-42), placing a cookie on said user system (column 12 lines 12-15), instant and prioritizing affiliations (column 10 lines 47-54), remuneration (column 12 line 61), and user system configuration access host site referral and display of member profile (columns 25 and 26).

Claims 26, 28, and 30-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (US 5,855,008) and Nielsen (US 5,854,630) wherein the claimed RLS or return link system is defined in functionality terms in Nielsen. In Nielsen, the cursor back or forward button placement allowing a list of recently visited URL's performs the same function, in the same manner or means, with the same result as the claimed RLS. Goldhaber is considered to disclose the claimed system comprising:

a RLS central server **106** configured to be accessed by a user system, and a RLS member, and a host site wherein said host site is located on a server; and wherein

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said user system is referred to said host site by a referring member (column 10 lines 1-38 wherein the computer network disclosure implies the claimed server);

said RLS central server configured with a referring member profile database to provide to said host site information associated with said referring member (column 10 lines 39-57 and column 13 lines 1-19 wherein the disclosed advertiser information implies member profile because viewed advertisements are used in determining member profile which is considered functionally equivalent to the claimed profile member association); and

wherein said information associated with said referring member comprising indicia sponsored by said referring member for display on said host site (column 10 lines 59-67 wherein the disclosed transaction payment implies the claimed indicia sponsorship). Goldhaber is considered to also disclose the claimed RLS storage configuration display and repository with filtering and updating including non-display members (column 13 lines 37-51), custom greeting indicia (column 13 line 20); demographics and history information (column 14 lines 47-49), a registration system (columns 13 and 14), prioritizing system (column 14 lines 56-60), and click through remuneration (column 16 lines 12-16).

Claim 35 is rejected under 35 U.S.C. 102(e) as being anticipated by Bezos et al. (US 6,029,141) and Nielsen (US 5,854,630) wherein the claimed RLS or return link system is defined in functionality terms in Nielsen. In Nielsen, the cursor back or forward button placement allowing a list of recently visited URL's performs the same

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function, in the same manner or means, with the same result as the claimed RLS.

Bezos is considered to disclose the claimed method comprising:

- allowing a user system to access a host site, therein said host site is located on a server (column 1 lines 17-23);

- determining if the user system was referred to said host site by a referring member (column 1 lines 39-41);

- retrieving information associated with said referring member from a referring member profile database (column 6 lines 21-30);

- receiving criteria from permitting instant affiliation (column 6 lines 31-40); and

- wherein said instant affiliates program further includes the following step:

- creating a links page on said host site for automatically affiliating members based on predefined criteria (column 6 lines 48-58).

Claim 36 is rejected under 35 U.S.C. 102(b) as being anticipated by Graber et al. (US 5,812,769) and Nielsen (US 5,854,630) wherein the claimed RLS or return link system is defined in functionality terms in Nielsen. In Nielsen, the cursor back or forward button placement allowing a list of recently visited URL's performs the same function, in the same manner or means, with the same result as the claimed RLS. In this claim, the recited RLS may be also considered patentably equivalent to the disclosed co-marketer. Graber is considered to disclose the claimed method comprising:

- allowing a user system to access a host site (column 4 lines 30-61);

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determining if the user system was referred to said host site by a referring member (column 4 line 62 through column 5 line 12);

retrieving information associated with said referring member from a referring member profile database (column 6 lines 23-38);

displaying on said host site indicia sponsored by said referring member (column 5 lines 25-55);

displaying said indicia on subsequent levels of pages within said host site (column 5 lines 56-67);

displaying said indicate on subsequent visits to said host site by said user system (column 6 lines 5-17);

retrieving and displaying information associated with said referring member from a RLS central repository (column 7 lines 44-66);

storing and retrieving demographics and history information from a demographics and history database and displaying said information to members (column 8 lines 42-46);

registering a RLS member (column 8 line 54);

using said indicia to return said user system from said host site to said return link destination (column 9 lines 61-63);

providing an instant affiliates program wherein said instant affiliates program (column 11 liens 63-67)further includes at least one of the following steps:

receiving criteria for permitting instant affiliation (column 12 line 2);

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creating an affiliate based on said criteria for permitting instant affiliation (column 12 line 8); and

providing remuneration (wherein the disclosed bounty is considered patentably equivalent to the claimed remuneration) to said referring member for at least one of the following:

a click-through; an impression; and a purchase (column 14 lines 1-15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston and Nielsen in view of Dolan et al. (US 5,801,702). Eggleston and Nielsen are considered to disclose the claimed invention as discussed above except for the claimed step of displaying said at least one indicia on subsequent levels of pages within

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said host site and said host site configured to display said at least one indicia on subsequent levels of pages at a domain name of said host site. Dolan is considered to disclose the claimed step of displaying said at least one indicia on subsequent levels of pages within said host site and said host site configured to display said at least one indicia on subsequent levels of pages at a domain name of said host site at column 5 lines 33-63. It would have been obvious to those skilled in art to combine the teachings of Eggleston and Nielson in view of Dolan for the purpose of having a method or means of tracking subsequent host pages sites including display so that users and hosts have an objective for determining the effectiveness of their displays.

Claims 5-7 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston and Nielsen in view of Wodarz et al. (US 5,999,912). Eggleston and Nielsen are considered to disclose the claimed invention as discussed above except for the claimed additional message line indicia, demographics and history information including display, and registration. Wodarz is considered to disclose the claimed additional message line indicia at column 2 line 5, demographics and history information including display at column 2 lines 7-13, and registration at column 3 lines 39-61. It would have been obvious to those skilled in art to combine the teachings of Eggleston and Nielson in view of Wodarz for the purpose of having a method or means of using indicia for registering users including demographic history so that users and hosts have an objective for determining the effectiveness of their displays.

Claims 8-12 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston and Nielsen in view of Nielsen et al. (US 5,854,630). Eggleston and Nielsen are considered to disclose the claimed invention as discussed above except for the claimed receiving specifications regarding URL of one of said at least one indicia, said at least one indicia being a logo, return link destination, and RLS metatag weighting factor. Nielsen is considered to disclose the claimed receiving specifications regarding URL of one of said at least one indicia, said at least one indicia being a logo, return link destination, and RLS metatag weighting factor at column 4 lines 50-65. It would have been obvious to those skilled in art to combine the teachings of Eggleston and Nielsen in view of Nielsen for the purpose of having a method or means for receiving specifications regarding URL of one of said at least one indicia, said at least one indicia being a logo, return link destination, and RLS metatag weighting factor so that users and hosts have an objective for determining the effectiveness of their displays.

Claims 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber and Nielsen in view of Eggleston et al. (US 6,061,660). Goldhaber and Nielsen are considered to disclose the claimed invention as discussed above except for the claimed list of member IP addresses for cross reference with an IP address of a referring web site to said host site and a list of user system IP addresses for cross reference with an IP address of said user system. Eggleston is considered to disclose the claimed list of member IP addresses for cross reference with an IP address of a

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referring web site to said host site and a list of user system IP addresses for cross reference with an IP address of said user system at column 10 lines 28-42. It would have been obvious to those skilled in art to combine the teachings of Goldhaber and Nielson in view of Eggleston for the purpose of having a method or means for a list of member IP addresses for cross reference with an IP address of a referring web site to said host site and a list of user system IP addresses for cross reference with an IP address of said user system so that users and hosts have an objective for determining the effectiveness of their displays.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber and Nielsen in view of Teare et al. (US 6,151,624). Goldhaber and Nielsen are considered to disclose the claimed invention as discussed above except for the claimed referring number, configured indication, and preferred indication. Teare is considered to disclose the claimed referring number, configured indication, and preferred indication at column 6 lines 26-67. It would have been obvious to those skilled in art to combine the teachings of Goldhaber and Nielson in view of Teare for the purpose of having a method or means for referring number, configured indication, and preferred indication so that users and hosts have an objective for determining the effectiveness of their displays.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Carrott (US 6,334,11), foreign reference N and non-patent literature reference U, all cited in this action are considered to teach means or processes of providing indicia on a web site.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is either steve.gravini@uspto.gov or stephen.gravini@uspto.gov. Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

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STEPHEN GRAVINI
PRIMARY EXAMINER

smg
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